

## **REMARKS**

Claims 39-47 are pending. Claims 1-32 and 34-38 were previously canceled, and claims 33 and 48-58 have been canceled herein without prejudice or disclaimer. Applicants expressly reserve the right to pursue these cancelled claims in future continuation or divisional applications.

Claims 39 and 40 have been amended. The amendments to Claim 39 merely rewrite the claim into independent form, incorporating the provisions of Claim 33, on which it formerly depended, in view of the cancellation of Claim 33. Claim 40 has been amended to depend on Claim 39 instead of now-canceled claim 33. Therefore no new matter has been added as a result of the amendments.

### **1. Claim Rejections – 35 USC § 112, 1<sup>st</sup> Paragraph**

The Office Action has rejected claims 48-53 under 35 U.S.C. 112, 1<sup>st</sup> paragraph under the assertion that they contain subject matter which was not disclosed in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action asserts that the limitations “for more than one day” and “for more than six days” do not appear to be disclosed within the instant application and thus are deemed new matter. Applicants respectfully traverse these assertions.

Nevertheless, solely in order to expedite the instant application to allowance, Applicants have cancelled claims 48-53, thus obviating their rejection.

### **2. Claim Rejections – 35 USC § 112, 2<sup>nd</sup> Paragraph**

The Office Action has rejected Claims 33, 39-47, and 51-53 under 35 USC 112, 2<sup>nd</sup> paragraph, under the assertion that they are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that there is no objective criterion or definition provided in the specification to apprise one of skill in the art of the meaning of the term “toxic concentration” recited in Claims 33 and 51. Applicants respectfully traverse these assertions.

As an initial matter, Applicants note that solely in order to expedite the instant application to allowance, Claims 33 and 51-53 have been canceled, thus obviating their rejection.

Furthermore, Applicants respectfully contend that the Office Action has applied an incorrect test for definiteness under 35 USC 112, 2<sup>nd</sup> paragraph. The test for definiteness is not whether a term is defined in the specification, or whether there are objective criteria provided in the specification. Rather, “the test for definiteness under 35 U.S.C. 112, second paragraph is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” MPEP 2173.02, citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

Nevertheless, solely in order to expedite prosecution, Applicants have removed the recitation of the phrase “toxic concentration” from the claims, obviating the rejection. Applicants therefore respectfully request reconsideration and withdraw of the rejection under 35 USC 112, 2<sup>nd</sup> paragraph.

### **3. Claim Rejections – 35 USC § 102**

The Office Action has rejected Claims 33, 40-47 and 54-58 under 35 USC 102(b) as anticipated by Guo and also as evidenced by Horwitz. Specifically, the Office Action asserts that Guo anticipates the claimed invention because Guo teaches HIV infected cells that have been treated with hyaluronidase, and that such cells would inherently have the same effect as the claimed composition when administered to a subject. Applicants respectfully traverse these assertions.

With regard to Claims 33 and 54-58, Applicants note that solely in order to expedite the instant application to allowance, these claims have been canceled, thus obviating their rejection.

With regard to Claims 40-47, Applicants note that these claims now ultimately depend from Claim 39. As acknowledged by the Office Action, Claim 39 is not anticipated by Guo. Thus, as dependent claims necessarily incorporate the limitations of the claim from which they depend, Claims 40-47 as pending are novel in view of Guo.

Based on the above, Applicants respectfully request reconsideration and withdraw of the rejection under 35 USC 102(b).

### CONCLUSIONS

Applicant respectfully contends that all conditions of patentability are met in the pending claims as amended and therefore respectfully request prompt allowance of the instant application.

If the Examiner believes it to be helpful, the Examiner is invited to contact the undersigned representative by telephone at (312) 913-3349.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

Dated: March 6, 2006

By: Sherri L. Oslick  
Sherri L. Oslick, Ph.D.  
Reg. No. 52,087